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REMARKS

Status of Prosecution

5 Applicant filed the original application on October 11, 2003. The Examiner mailed a first, nonfinal office action on August 18, 2004. The Examiner mailed a second, nonfinal office action on January 5, 2005. This paper is in Response to the second office action. Applicant requests reconsideration and withdrawal of the rejections raised in that office action.

10 Claims 1 through 30 are pending. In the instant Office Action, the Examiner rejected claims 1-30. Claims 1, 9, 16 and 26-29 are currently amended. Claims 5-8, 10-11 and 23-25 are currently cancelled.

15 Claim Rejections

35 U.S.C. §102

The Examiner rejected claims 1-4, 9, 10, 12-14, and 16-23 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 1,969,969 to Dunagin ("Dunagin"). The rejection is respectfully traversed.

20 For fundamental teaching on the doctrine of anticipation, one must consider the decision of Judge Rich in *In re William J. King*, 801 F.2d 1324, 231 U.S.P.Q. 136 (Fed. Cir. 1986);

25 It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim, and that anticipation is a fact question subject to review under the clearly erroneous standard. *Lindemann Maschinenfabrik v. American Hoist and Derrick*, 730 F.2d 1452, 1457, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). Our review of a finding of anticipation is the same whether it was made by the board or by a district court.

30 *In re William J. King*, 801 F.2d at 1326 (emphasis added).

Further, for a reference to anticipate a claim under 35 U.S.C. §102, that reference must teach, or identically describe, each and every element or step of the claim. See, e.g., *Jamesbury Corp. v. Litton Industrial Products*, 756 F.2d 1556, 225 USPQ 253 (Fed. Cir. 1985).

Anticipation" is a restrictive concept, requiring the presence in a single prior art disclosure of

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each and every element of a claimed invention. The test for infringement by anticipation should be rephrased as, "That which would *literally* infringe if later in time anticipates if earlier than the date of the invention." *Lewman Marine, Inc. v. Barent, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987) (emphasis in original). Further, as held in *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1896 (Fed. Cir. 1991), "there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." (emphasis added). The Dunagin reference does not disclose the identical structure claimed by Applicant.

Although Applicant respectfully traverses the rejection, Applicant has amended independent claims 1, 9 and 16 to include Applicant's handles and use thereof, in order to hasten prosecution of the Application and to receive earlier allowance. Dunagin clearly does not include any type of handle or handles. This fact was admitted by the Examiner on page 3 of the second office action: "Dunagin does not disclose a handle as claimed." Because the handle elements are missing from Dunagin, Dunagin cannot anticipate claim 1.

Dependent claims 2-4 necessarily include the elements of claim 1. As independent claim 1 is distinguished over Dunagin, dependent claims 2-4 are similarly distinguished. Dunagin does not anticipate each and every claim element of claims 1-4 of the application, and reconsideration and withdrawal of the rejection is requested.

With respect to independent method claim 9, Dunagin similarly does not demonstrate use of any handle or handles. Because the handle step is missing from Dunagin, Dunagin cannot anticipate claim 9.

Dependent claim 10 has been cancelled. Dependent claims 12-14 necessarily include the steps of claim 9. As independent claim 9 is distinguished over Dunagin, dependent claims 12-14 are similarly distinguished. Dunagin does not anticipate each and every claim step of claims 9 and 12-14 of the application, and reconsideration and withdrawal of the rejection is requested.

With respect to independent claim 16, Dunagin does not demonstrate any handle or handles. Because a handle is missing from Dunagin, Dunagin cannot anticipate claim 16.

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Dependent claim 23 has been cancelled. Dependent claims 17-22 necessarily include the elements of claim 16. As independent claim 16 is distinguished over Dunagin, dependent claims 17-22 are similarly distinguished. Dunagin does not anticipate each and every claim element of claims 16-22 of the application, and reconsideration and withdrawal of the rejection is requested.

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Rejection Under 35 U.S.C. §103

The Examiner rejected claims 5-8, 11 and 24-29 under 35 U.S.C. § 103(a) as unpatentable over Dunagin in view of U.S. Patent No. 1,484,036 to Mason ("Mason"). The rejection is respectfully traversed. Applicant submits that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

As succinctly stated in the MPEP, to establish a *prima facie* case of obviousness, three basic criteria must be satisfied: (1) a suggestion or motivation to combine reference teachings; 10 (2) a reasonable expectation of success, and (3) the prior art references must teach or suggest all the claim limitations. See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vacck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

20 Claims 5-8, 11, and 24-25 have been cancelled. However, some subject matter from these claims has been incorporated into the respective base independent claims. (See discussion above regarding handles with respect to the 102 rejections.) Thus, remarks are made here for allowing independent claims 1, 9, 16 and dependent claims 26-29.

The Examiner stated:

25 Dunagin does not disclose a handle as claimed. Mason discloses an outer handle 43, 2 and an inner handle 44 that are effectively squeezed together for the purpose of moving a lower body part 45

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relative to a main body part 10. Furthermore, the outer handle of Mason is slidably engaged with the main body part 10 and connects to the lower body component 45. Inner handle 44 is connected to the main body part as well.

5 Second Office Action, page 3. Applicant respectfully submits that the Examiner has misunderstood the configuration and operation of Mason.

The reference numbers "2", to the left and right of Fig. 1, on Mason represent the transverse horizontal section line of Fig. 1 of which the view is taken for Fig. 2. Mason, column 1, lines 44-47. The reference numbers "2" do not represent any type of handle or handle component.

10 Also, there is no "outer handle 43, 2 and an inner handle 44 that are effectively squeezed together for the purpose of moving a lower body part 45 relative to a main body part 10." Operating handle 43 and locking device 44 simply provide the tension needed for securing the cable in the device. They are not used as "handles" for the device. Component 44 of Mason is a "locking device" that "has threaded connection with the screw and is engageable with the threaded bearing to releasably secure the shaft in any position to which it may be adjusted." Id. column 3, lines 20-25 (emphasis added). The locking device of Mason is exactly that, a "locking device." It cannot be moved by squeezing it together with operating handle 43. It must be turned, upon screw shaft 41, which is in threaded bearing 42, in order to secure the shaft 41 in a particular position.

15 "At its outer end the screw shaft 41 has connected thereto an operating handle 43 and between the operating handle and the threaded bearing a locking device 44. . ." Id., col. 3, lines 17-21. Note that the apparatus of Mason is "adapted to be mounted upon the upper end of the well casing or the like." Mason, col. 1, line 56 through col. 2, line 2.

20 The operating handle 43 is mounted upon the screw shaft 41 as well. There would be no way to squeeze locking device 44 together with operating handle 43 because they are both secured onto the same threaded shaft 41. While the apparatus (M) of Mason is mounted upon the

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well casing, operating handle 43 is twisted thereby bringing the tension block 45 and tension rollers 50 closer to the cable C. This also compresses spring 48, which acts as a sort of cushion. Then, locking device 44 is tightened by turning it on the threaded shaft 41 against threaded bearing 42 to lock the shaft 41 in place. Locking device 44 simply provides added security 5 against the shaft 41 from turning/moving back out of bearing 42; it is not a handle of any sort.

Further, the operating handle 43 of Mason is not slidably engaged with a main body part as stated by the Examiner. The operating handle 43 of Mason is affixed at the end of screw shaft 41, which is inserted through threaded bearing 42. A screw shaft cannot slide through a threaded bearing. It would need to be turned.

10 Referring to claims 1, 9, and 16 currently amended, Dunagin and/or Mason do not teach or even suggest that claimed by Applicant. As admitted by the Examiner, Dunagin does not disclose a handle. And, Mason provides no means whatsoever for automatically moving a main body component towards a lower body component to engage a line. As stated, the operating handle 43 of Mason must be manually turned by hand to bring tension rollers 50 in toward the 15 cable. Further, Mason has no inner and outer handles as claimed by applicant. Thus, independent claims 1, 9, and 16 are clearly distinguished over Dunagin and Mason, as there is no teaching or suggestion in either of these references for that claimed by applicant. Dependent claims 26-29 necessarily include the elements of claim 16 and are likewise distinguished. It 20 would require impermissible hindsight to combine teachings from patents issued in 1922 and 1934 to come up with that claimed in the Application.

25 The Examiner rejected claim 15 over Dunagin in view of Adamson et al. and claim 30 over Dunagin and Mason, and further in view of Adamson et al. The rejections are respectfully traversed. Applicant submits that the differences between the subject matter sought to be patented, and the references cited by the Examiner, are not such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

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Claim 15 depends indirectly from independent claim 9, currently amended. Applicant disagrees with the rejection of claim 15 - even as it stood prior to amendment of claim 9. The Adamson spring 36 would not work if used on the Dunagin device. If a compression spring were used on Dunagin in place of spring 15 of Dunagin, then it would pull yoke 10 of Dunagin away from frame 1 thereby letting go of the cable instead of retaining it.

Further, as discussed above, and as admitted by the Examiner, neither Dunagin nor Adamson teach or disclose a handle. Claim 15 is therefore clearly distinguished over Dunagin in view of Adamson et al.

Claim 30 states that the "means for creating a spring-like force comprises a spring inserted over said shaft of said outer handle." The Examiner states, "Adamson et al. discloses a compressed spring 36 over a shaft . . ." Second Office Action, page 4. But the spring 36 of Adamson et al. is not over a shaft of a handle as claimed. Adamson et al. has no handle whatsoever. See, Adamson et al., Fig. 1. And, the Examiner admits that "neither Dunagin nor Mason disclose a spring over a shaft as claimed." Claim 30 is clearly distinguishable over Dunagin and Mason, and further in view of Adamson et al.

Conclusion

For the reasons set forth above, Applicant requests reconsideration and withdrawal of the foregoing rejections.

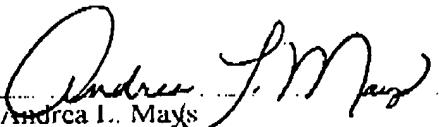
Applicant submits that the actions taken by Applicant do not raise new issues that would require further consideration or a new search and do not raise new matter.

In conclusion, Applicant asserts that this Response is complete as contemplated in 37 CFR §1.111, that all claims are patentable for the reasons set forth above, and that the Application is now in condition for allowance. Accordingly, Applicant requests an early notice of allowance. The Examiner is invited to call the undersigned at (505) 867-6850 for any reason that would advance the instant application to issue.

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Respectfully submitted,

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